

REMARKS

Claims 4, 5 and 7-10 stand cancelled without prejudice; claims 1-3 and 6 have been amended and new claims 11 and 12 have been added. The specification also has been amended on page 56 in two instances merely to correct a typographical error. No new matter is presented by virtue of the within amendment. For instance, the subject matter of new claim 11 is supported by the description at page 26, line 28 through page 27, line 34 of the specification. Newly added claim 12 is supported by the description at page 34, lines 24 to 34 of the specification.

Referring to the Office Action, the specification stands objected to for certain informalities. It is believed the within amendments obviate the objection. For instance, the specification has been amended to correct two typographical errors appearing on page 56 (lines 9 and 17) of the application. Thus, withdrawal of the objection is requested.

Claims 1-3 and 6-7 stand rejected under 35 USC §101, as allegedly being directed to non-statutory subject matter. It is believed the within amendments obviate the objection. For instance, claim 7 has been cancelled and claims 1-3 and 6 have been amended, as suggested by the Examiner, to recite --isolated and purified-- in reference to the oxytocin secretion regulator. By virtue of this amendment, the subject matter of the present invention is readily differentiated from the naturally occurring compounds.

Claims 8-9 also stand rejected under 35 USC §101, as allegedly not being of proper process claim format. Again, it is believed the within amendments obviate the objection. For instance, claims 8-9 have been cancelled favor of newly added claim 11. New claim 11 recites a proper process claim, thus withdrawal of the rejection is proper.

Claims 1-3, and 6-10 stand rejected under 35 USC §112, 2nd paragraph, for various informalities and certain aspects allegedly requiring clarification.

It is believed that the within amendments obviate the rejection. For instance, claim 1 has been amended to identify the G protein-coupled receptor protein as --phGR3--. The nucleotide and amino acid sequence of phGR3 are disclosed in the specification of WO 96/05302; see the related discussion in the present application at page 33, line 17 through page 34, line 4 of the specification. Additionally, claim 2 has been amended to replace the phrase "the same or substantially the same as" with --has at least 80% identity to--, thus clarifying the subject matter of the invention in that claim. Further, with reference to the rejection of claim 6, since the isolated and purified oxytocin secretion regulator has been structurally defined in the amended claim 1, it is believed that the subject matter of amended claim 6 is also clear and definite. Still further, throughout the specification the term "oxytocin secretion promoter" is described and utilized as one of the "oxytocin secretion regulators". Claim 6 has been amended to reflect this feature. Lastly, claims 7 through 10 have been cancelled and new claims 11-12 added. Thus, it is believed that the within amendments obviate each of the rejections under 35 USC §112, 2nd paragraph. Thus, reconsideration and withdrawal of the rejection are requested.

Claims 1, 2, 3, 6, 8 and 9 stand rejected under 35 USC 112, 1st paragraph, allegedly for lack of enablement. The Office Action expressly acknowledges that the specification is enabling for an isolated and purified oxytocin secretion regulator, comprising a ligand peptide which has the amino acid sequence represented by SEQ ID NO: 3, SEQ ID NO: 18, SEQ ID NO: 32 and SEQ ID NO: 44, or a salt thereof, for G protein-coupled receptors phGR3 and UHR-1. However, the position is taken that the specification does not reasonably provide enablement for other oxytocin secretion regulators. Claims 1-2, and 6-10 also stand rejected under 35 USC 112, 1st paragraph, allegedly as lacking adequate written description.

While Applicants believe that the full scope of the claims satisfy the requirements of 35 USC §112, 1st paragraph, including its enablement and written description requirements, it also is

believed that the within amendments obviate the rejection. For instance, the claims have been amended such that the oxytocin secretion regulator has been specified structurally. Additionally, its function is disclosed and amply enabled by the specification, e.g., particularly in Example 2 and Figure 2. Thus reconsideration and withdrawal of the rejection are requested.

Claims 1-3, 6 and 8-9 stand rejected under 35 USC §102(b), over WO 97/24436 to Takeda Chemical Industries Ltd. The Office Action asserts that WO 97/24436 discloses an amino acid sequence which has 100% sequence identity to the amino acid sequence represented by SEQ ID NO: 3, 18, 32 and 44 of the present application.

The rejection is traversed. The cited reference does not teach or suggest the claimed oxytocin secretion regulators or methods of the invention in any manner to sustain the §102 rejection (or even a §103 rejection if it were to be applied).


For instance, the cited reference provides no disclosure or even suggestion of oxytocin secretion and/or regulation of oxytocin secretion. In contrast, the present application provides a description of the relationship between oxytocin and the ligand throughout the specification; see also Example 2 and Figure 2. Additionally, the within amendments further define and clarify the features of the present invention, thereby further distinguishing the present invention from the cited reference.

Reconsideration and withdrawal of the rejection are therefore requested. [See, for example, *In re Marshall*, 198 USPQ 344, 346 (CCPA 1978) ("[r]ejections under 35 U.S.C. §102 are proper only when the claimed subject matter is identically disclosed or described in the prior art.")]

Matsumoto et al.
U.S.S.N. 09/868,885
Amendment
Page 8

It is believed the application is in condition for immediate allowance, which action is earnestly solicited.

Respectfully submitted,



Christine C. O'Day (Reg. 38,256)
EDWARDS & ANGELL, LLP
P.O. Box 55874
Boston, MA 02205
Tel. (617) 439-4444

BOS_444984.1